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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,933	11/13/2003	Achim Buchholz	P-US-PR 1090	9887

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EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/712,933

Applicant(s)

BUCHHOLZ, ACHIM

Examiner

Michael W. Talbot

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 4-10 and 15-22 is/are objected to.
- 8) ☒ Claim(s) 23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/30/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a tool holder for a rotary hammer, classified in class 279, subclass 19.
 - II. Claim 23, drawn to a Method for forming through holes/apertures in a tool holder, classified in class 29, subclass 557.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as an Electric Discharge Machine to form the through holes/apertures.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Michael P. Leary on Tuesday, 20 December 2005, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claim 23 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

2. The disclosure is objected to because of the following informalities:

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Refer to page 8 of 15, paragraph [0025], line 1, the character reference "10" should be deleted from the phrase "opening 10" since it has been used throughout the specification to define the holder body.

Refer to page 8 of 15, paragraph [0026], line 9, the word "of" should be deleted from the phrase "of made of elastic material" so as to read --made of elastic material--.

Refer to page 10 of 15, paragraph [0032], line 3, the character reference "chisel shank 3" should be changed to read --chisel shank 30--.

Refer to page 10 of 15, paragraph [0032], lines 5 and 6, the character reference "chisel shank 3" should be changed to read --chisel shank 30--.

Appropriate correction is required.

Claim Objections

3. Claim 1 is objected to because of the following informalities:

Refer to claim 1, line 6, insert a comma " , " between the phrases "on an insert (42)" and "the or each of which" so as to read --on an insert (42), the or each of which--.

Refer to claim 1, line 7, insert the word "driving" between the phrases "so that the" and "rib extends axially" so as to read --so that the driving rib extends axially--.

Refer to claim 1, line 9, the word "releasably" is misspelled and should be changed to read --releaseably--.

Appropriate correction is required.

4. Claims 4-10 and 15-22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and/or should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

7. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the radially inward facing surface" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bongers-Ambrosius et al. '018 in view of EPO 0013646. Bongers-Ambrosius et al. '018 shows in Figure 1 a tool holder for a rotary hammer comprising a tube like tool holder (5) have a side wall formed with at least one through hole (5a) for receiving a locking body (4) for releaseably engaging a corresponding axial closed groove (col. 2, lines 47-52) of a tool bit (1) and also formed with at least one additional through hole (5b). Bongers-Ambrosius et al. '018 shows at least one hardened metal driving rib (lower corner) located on an insert (8) fitted within a corresponding additional through hole so that the rib extends axially and radially inward (Fig. 1)

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for releaseably engaging a corresponding axial open driving groove (3). Bongers-Ambrosius et al. '018 shows the insert having a base (bottom surface of cylinder) shaped to fit the through hole. Bongers-Ambrosius et al. '018 lacks the additional through hole (5b) being formed by at least two overlapping axially offset circular cross-sectioned through holes.

EPO 0013646 shows in Figures 1-5 the through hole (44,76) having at least two overlapping axially offset circular cross-sectioned through holes (dotted lines 78,80) with a corresponding shaped insert (50) having a rib (lower portion at 70) for driving the tool (18). In view of this teaching of EPO 0013646, it would have been obvious to one of ordinary skill in the art to modify the tool holder assembly of Bongers-Ambrosius et al. '018 with the alternate shaped driving assembly taught by EPO 0013646 to prevent accidental separation due to the contour of the driving insert/through hole combination while still allowing for quick and easy assembly/disassembly of the driving insert to facilitate replacement.

10. Claims 1-3 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bongers-Ambrosius et al. '018. Bongers-Ambrosius et al. '018 does not disclose expressly that the additional through hole (5b) is formed in a cylindrical shape with a matching cylindrical driving insert. Instead, Bongers-Ambrosius et al. '018 indicates through Figure 1 that the additional through hole (5b) is formed in a cylindrical shape with a matching cylindrical driving insert. At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select "at least two overlapping axially offset circular cross-sectioned through holes and a matching shaped driving insert" because Applicant has not disclosed that the "particular shaped of the through hole and matching insert" provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the driving insert/through hole combination of Bongers-Ambrosius et al. '018, and Applicant's driving insert/through hole combination to

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perform equally well with either the cylindrical shape taught by Bongers-Ambrosius et al. '018 or the claimed "at least two overlapping axially offset circular cross-sectioned through holes with a matching cylindrical driving insert" because both shapes would provide the required surface area contact to transmit a high torque to drive the tool.

Furthermore, Applicant does not provide any criticality or unexpected results for the at least two overlapping axially offset circular cross-sectioned through holes as recited in claim 1.

Conclusion

11. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot
Examiner
Art Unit 3722
21 December 2005



BOYER D. ASHLEY
PRIMARY EXAMINER